



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,307	11/21/2001	Jukka Vialen	4925-137PUS	2183

7590 06/24/2004

Michael C Stuart
Cohen Pontani Lieberman & Pavane
551 Fifth Avenue Suite 1210
New York, NY 10176

EXAMINER

ZEWDU, MELESS NMN

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,307

Applicant(s)

VIALEN ET AL. 

Examiner

Meless N Zewdu

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☒ Claim(s) 6-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment (A)

1. This action is in response to the communication filed on 4/15/04.
2. Claims 6-20 are newly added claims.
3. Claims 1-20 are pending in this action.
4. Claims 6-20 are withdrawn from further consideration (see below).
5. Ground of rejection has been changed due to newly discovered prior art (US 5,854,981).

Specification

The disclosure is objected to because of the following informalities: in the "Technical Field of the Invention", applicant, instead of stating the technical field, improperly makes a reference to the preamble of the first independent claim (claim 5).

Appropriate correction is required.

Election/Restrictions

Newly submitted claims 6-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: in the original claims (claims 1-5), cell selection message is initiated by the network so as to change the mobile station to a cell-connected state and the selected cell to be used by the

Art Unit: 2683

mobile station in that cell-connected state. However, in the newly added claims (claims 6-20), a radio access network is provided to select a cell by a mobile station in the common channel state after the mobile station is transitioned from a dedicated channel state to the common channel state, whose channel state is different from what is provided in the original claims. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (APA) in view of Wallstedt et al. (Wallstedt) (US 5,854,981).

As per claim 1: the APA discloses a method for use in a cellular telecommunications network for selection of a cell for use by a mobile station in a cell-connected state, said cellular telecommunications network comprising a plurality of radio access networks

having cells, said calls being grouped into registrations areas, and said mobile station having a plurality of states, said states comprising an idle-mode state; a registration - area-connected state, in which state the location of a mobile station is known to the cellular telecommunications network on a registration area level; and cell connected state, in which state the location of a mobile station is known to the cellular telecommunications network on a cell level (see fig. 1; page 2, lines 6-34). Furthermore, the APA also discloses cell selection to be used by the mobile station in the cell-connected state (see page 3, lines 23-32). Indicating the selected cell by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell connected state would have been inherent to the APA system. Otherwise no cell would be recognized/identified and hence utilized. But, the APA does not explicitly teach about --- selecting, by the network a cell to be suggested as the cell for use by the mobile station, as claimed by applicant. However, in a related field of endeavor, Wallstedt teaches about adaptive neighbor cell list wherein the cellular system creates a neighbor cell list that accounts for the differing coverage areas of cells that would allow creation of a neighbor cell list that would contain the best possible candidate cells for handoff of a call (see col. 3, lines 57-66). Furthermore, a selected cell of the system, data associated with the selected cell and each of the plurality of neighboring base stations is collected and the collected data may include a plurality of events indicative of quality of handoffs from the selected cell to each of the neighboring base stations (see col. 4, lines 7-57; figs. 5-7; col. 12, lines 10-23). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made

Art Unit: 2683

to modify the APA with the teaching of Wallstedt for the advantage of creating a neighbor list that accounts for the different coverage areas of cells (see col. 3, lines 57-59).

As per claim 2: the method wherein said message is a Radio Resource Control (RRC) message reads on the APA (see page 2, lines 23-25). When the references are combined as shown above, the message would be a Radio Resource Control (RRC) message.

As per claim 3: the method further comprising the steps of:

selecting, by the mobile station, a cell for use in the cell-connected state, and indicating, by the mobile station, the selected cell by attaching cell identification information as a parameter to a second message reads on the APA (see page 3, lines 23-32). The APA shows that the UE/mobile station is capable of selecting a cell for use in the cell-connected state.

As per claim 4: the method wherein the step in which the mobile station selects a cell comprises the steps of:

selecting from a set of cells comprising cells known by the mobile station and said cell suggested by the network reads on the APA (see page 3, lines 23-32). It is obvious that the mobile station would not be able to select a cell from a group of cells it does not know. Technically not feasible. Furthermore, when the references are combined as shown above, the APA network would be able to select/suggest a cell which the mobile station may approve of and use.

Allowable Subject Matter

Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N Zewdu whose telephone number is (703) 306-5418. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Meless Zewdu
Examiner

M-Z



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

18 June 2004.